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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/508,987      | 09/27/2004  | Marjatta Vahvaselka  | 227-156             | 7616             |

23117 7590 11/22/2006

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EXAMINER

LILLING, HERBERT J

ART UNIT PAPER NUMBER

1657

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/508,987

Applicant(s)

VAHVASELKA ET AL.

Examiner

HERBERT J. LILLING

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9-27-2004 preliminary amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Receipt is acknowledged of the preliminary amendment and prior art information disclosure statement filed September 27, 2004 and a prior art information disclosure statement filed September 11, 2006.

2. Claims 1-20 are present in this application which is a 371 of PCT/FI03/00236 filed March 27, 2003 which claims foreign priority to Finland 2000203593 filed March 27, 2002.

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-12 and 14-18, drawn to a process for preparing conjugated Linolenic acid by microorganisms, characterized by hydrolyzing oat fat and isomerizing the linoleic acid released in the hydrolysis into conjugated linoleic acid by the microorganisms.

Group II, claim(s) 13, drawn to a process according to claim 1, characterized in that the preparation of conjugated linoleic acid occurs in connection with the preparation of a food product which claim is improper as it does not further limit claim 1 and cannot be properly searched or examined.

Group III, 19, drawn to oat PRODUCT for use in the preparation of conjugated linoleic acid.

Group IV, claim 20, drawn to a process for preparing conjugated linoleic acid from linoleic acid, characterized in that oat is used as the source of linoleic acid which does not specify any process steps and which claim is considered not to be within the

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scope of 35 USC 101 35 U.S.C. 101 statutory basis in view of the requirements as required as stated:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1 since Inventions III is considered to lack the single general inventive concept as oat is a natural product and cannot be patented. In addition, Invention IV lacks the same single general inventive concept as Invention I.

Furthermore, the PCT record clearly indicates the nonpatentability of claimed inventions which lack a single inventive concept for the above three Groups.

4. This application contains claims directed to the following patentably distinct species:

A. Whereby the grain [claim 2 lacks antecedent basis] is selected from the group consisting of:

- a. untreated oat;
- b. pretreated oat;
- c. oat fraction.

B. Whereby hydrolysis is caused by:

- h. enzyme activity of oat;
- i. adding external enzyme activity-please specify the outside source.

C. Whereby the propionic acid bacterium [please note that the expression propionic acid bacterium lacks antecedent basis in claims 6-7] is selected from the group consisting of:

- i. *Propionibacterium freudenreichii* ssp. *freudenreichii* ;
- ii. *Propionibacterium freudenreichii* ssp. *Shermanii*.

ii. a Propionibacterium freudenreichii ssp. shermanii JS,  
DSM 7067

ii. b Or any other species of Propionibacterium  
freudenreichii ssp. Shermani.

**Please note Applicant does not have support for the claimed species DSM  
in the instant specification.** However, Applicant is entitled to insert the support from  
the original claim in the instant specification for support of the claimed strain. It is noted  
that the strain is available to the public without restriction in accordance with U.S.  
6960456 patent.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for  
prosecution on the merits to which the claims shall be restricted if no generic claim is  
finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification  
of the species that is elected consonant with this requirement, and a listing of all claims  
readable thereon, including any claims subsequently added. An argument that a claim  
is allowable or that all claims are generic is considered nonresponsive unless  
accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration  
of claims to additional species which depend from or otherwise require all the limitations  
of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

5. Applicant should note that the following, which probably will be rejected unless, corrected for the following claims:

x. The term “characterized” is not defined in the specification, which probably will be considered to be vague and indefinite in scope.

y. The term “preferably” in claims 7, 10 (two indications), 15 (two indications) and 17 in view of the following:

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim \*\*\* recites the broad recitation \*\*\*, and the claim also recites \*\*\* which is the narrower statement of the range/limitation.

z. The term “possibly” probably will be rejected as being vague and indefinite.

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6: Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Applicant is entitled to rejoinder of process claims in accordance with this Tech Center Policy in view of the following:

**F.P.: Ochiai/Brouwer Rejoinder form paragraph**

The examiner has required restriction between product and process claims. **Where applicant elects claims directed to the product, and a product claim is subsequently found allowable**, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

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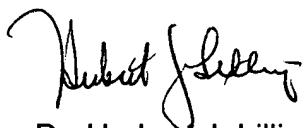
Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

8. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is 571-272-0918 and Fax Number is (703) 872-9306 or SPE Jon Weber whose telephone number is 571-272-0925. Examiner can be reached Monday-Friday from about 7:30 A.M. to about 7:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Information regarding the status of an application may be obtained from the Patent Application information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.J.Lilling: HJL  
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Art Unit **1657**  
November 14, 2006



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